

REMARKS

Applicants appreciate the Examiner's acknowledgement of priority of the present invention under 35 U.S.C. § 120, but respectfully disagree with the characterization by the Patent Office of priority under § 119(e) for claims 1-31, 43, and 44. Applicants believe that at least a portion of these claims finds support, inherently if not expressly, in one or more of Patent Application Nos. 09/174,981, 60/085,109, or 60/062,531.

Applicants respectfully request a copy of the Information Disclosure Statement in the next communication from the Patent Office.

As the Petition to Correct the Unintentionally Delayed Benefit Claim filed December 16, 2003 was dismissed and the amendment was not accepted, Applicants have marked up the priority claim in the specification with respect to the originally filed priority claim. Applicants also submit herewith a Renewed Petition to Correct the Unintentionally Delayed Benefit Claim.

The priority claim has also been updated to include the current status of application 09/827,806.

In the drawings, the copy marks on Figures 31 and 33C have been deleted, and Figures 35, 36A, 40A, and 40B have been clarified.

Applicants have amended claim 1 to delete "La." Support for this amendment can be found in the specification, for example, on page 8, lines 1-4.

Applicants have rewritten original claim 1 as new claim 45, deleting "Fe." Support can be found in the specification, for example, on page 8, lines 1-4. Multiply dependent claims 4, and 7-12 have also been amended to depend from new claim 45, as well as claims 1, 2, and 3. It is not seen where in the prior art is there a disclosure or a suggestion of an electromechanically active material comprising a perovskite compound of the formula, $(\text{Na}_{1/2}\text{Bi}_{1/2})_{1-x}\text{M}_x(\text{Ti}_{1-y}\text{M}'_y)\text{O}_{3\pm z}$, where M is one or more of Ca, Sr, Ba, Pb, Y, La, Pr, Nd, Sm, Eu, Gd, Tb, Dy, Ho, Er, Tm, Yb and Lu; and M' is one or more of Zr, Hf, Sn, Ge, Mg, Zn, Al, Sc, Ga, Nb, Mo, Sb, Ta, W, Cr, Mn, Co and Ni, and $0.01 < x < 0.3$, and $0.01 < y < 0.3$, and $z < 0.1$.

Applicants have also amended the specification to state that "Examples of polycrystalline materials include materials having the form of rods, fibers, ribbons, or sheets." Support for this amendment can be found in claim 5 as originally filed. Thus, no new matter has been added.

Claims 1-31 and 43-45 are now pending in the application. Claims 32-42 have been withdrawn. Applicants thank the Examiner for the allowance of claims 2 and 3.

Rejections under 35 U.S.C. §112, ¶ 1

Claims 5, 17, 18, 30, and 31 have been rejected under 35 U.S.C. §112, ¶ 1 as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors have possession of the claimed invention at the time the application was filed.

Applicants respectfully disagree. Applicants believe that one of ordinary skill in the art, in reading the specification in light of claims 5, 17, 18, 30, and 31, would understand that the invention as claimed was in possession of the inventors at the time of filing. For support, the examiner is directed to the specification as a whole, specifically Example 5. Thus, withdrawal of the rejection of these claims is respectfully requested.

Claims 1-3, 15, and 16 have been rejected as not being supported by the specification (although no ground of rejection is given, it is assumed that the rejection is made under 35 U.S.C. §112, ¶ 1). Applicants note that claims 1-3, 15, and 16 are originally filed claims in the instant application, as well as the parent application to which the instant application claims priority (09/827,806). These claims thus constitute part of the originally-filed specification. Moreover, Applicants believe that the specification teaches not only single crystalline or textured crystalline materials, but other crystalline structures as well, for example, polycrystalline materials or textured polycrystalline materials, e.g., as discussed in Example 5, which may include materials in the form of rods, fibers, ribbons, sheets, etc. Thus, for at least these reasons, withdrawal of the rejection of these claims is respectfully requested.

The Office Action additionally states that the “definitions of the variables in claims 30 and 31 do[] not appear to be present in the specification.” Applicants are unclear as to the nature of this rejection. Claim 30 includes the variables M, M', M'', α , β , γ , δ , and z, each of which has been defined within claim 30 in lines 4-10. Thus, it is not clear which variable the Office Action is referring to. However, all of these variables have been properly defined within claim 30. Support for “ $M_{\alpha}Bi_{\beta}M'_{\gamma}M''_{\delta}O_{3+z}$ ” can also be found in the specification, for example, on p. 16, lines 12-13. Thus, it is respectfully requested that the rejection of claim 30 be withdrawn. Claim 31 depends on claim 30 and recites a more narrow range for the variable β , and is thus also believed to be clear. Withdrawal of the rejection of claim 31 is thus respectfully requested.

If the Patent Office is referring to the elemental abbreviations within claim 30 (e.g., Na, K, Rb, Cs, etc.), it is believed that one of ordinary skill in the art would clearly recognize that

these are abbreviations of the chemical elements within the Periodic Table (e.g., sodium, potassium, rubidium, cesium, etc.).

Double Patenting Rejections

Claims 13-31, 43, and 44 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 9-17, 22, 23, 35, 36, 40, and 41 of U.S. Patent No. 6,231,779. However, the Office Action stated that a timely filed Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) may be used to overcome this rejection.

Without acceding to the correctness of this rejection, enclosed herewith is a Terminal Disclaimer with respect to U.S. Patent No. 6,231,779 in compliance with 37 C.F.R. §1.321(c) to overcome this rejection. In view of this Terminal Disclaimer, claims 13-31, 43, and 44 are believed to be allowable. Withdrawal of the rejection of these claims is therefore respectfully requested.

The comments concerning claims 15-17 and 20-29 by the Patent Office are unclear, and Applicants respectfully request clarification. It appears that claims 15-17, and 20-29 of the instant application are treated as having been rejected for obviousness-type double patenting in view of said U.S. Patent No. 6,231,779. However, in view of the above-identified Terminal Disclaimer with respect to U.S. Patent No. 6,231,779, it is believed that any such rejection is moot (the Applicants do not concede that such a rejection has been made).

Rejections Under 35 U.S.C. §102(a)

Claims 1 and 4-12 have been rejected under 35 U.S.C. §102(a) as being anticipated by JP 2001-48641. The Office Action asserts that the Japanese reference teaches a composition having a molecular formula $(\text{Na}_{1/2}\text{Bi}_{1/2})_{1-x}\text{La}_x\text{Ti}_{1-x}\text{Fe}_x\text{O}_3$, where $0 < x \leq 0.3$.

Applicants do not concede to the accuracy of the computer-translated version of JP 2001-48641, as provided. Nevertheless, Applicants do not see where, in JP 2001-48641, is there a disclosure or suggestion for a perovskite comprising one or more of Ca, Sr, Ba, Pb, Y, Pr, Nd, Sm, Eu, Gd, Tb, Dy, Ho, Er, Tm, Yb and Lu, as claimed in claim 1. Accordingly, it is respectfully requested that the rejection of claim 1 be withdrawn. Claims 4-12 depend, directly

or indirectly, from claim 1, and it is respectfully requested that the rejection of these claims also be withdrawn for at least these reasons.

CONCLUSION

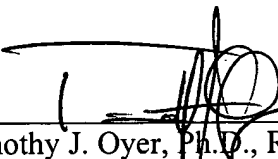
In view of the foregoing, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' representatives at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time.

If there is a fee occasioned by this response, including an extension fee that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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Art Unit: 1755

IN THE DRAWINGS

A Request for Approval of Proposed Drawing Corrections is enclosed along with the revised Figures 31, 33C, 35, 36A, 40A, and 40B.